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10/588,217	08/02/2006	Jurgen Tropsch	29377US0PCT	5753
22850	7590	06/04/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			POWERS, FIONA	
ART UNIT	PAPER NUMBER			
	1626			
NOTIFICATION DATE	DELIVERY MODE			
06/04/2009	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/588,217	Applicant(s) TROPSCH ET AL.
	Examiner Fiona T. Powers	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 March 2009.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11 and 19-45 is/are pending in the application.

4a) Of the above claim(s) 19-22,30-32,34-37 and 45 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11, 23-29, 33 and 38-44 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claims 11 and 19 to 45 are pending in the application.

Election/Restrictions

New claims 19-22, 30-32, 34-37 and 45 are drawn to an invention that was non-elected with traverse in the reply filed October 16, 2008.

The restriction requirement presented in the office action mailed September 16, 2008 was made final in the previous office action mailed December 26, 2008 for the reasons given therein.

Therefore, claims 19-22, 30-32, 34-37 and 45 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 16, 2008.

This application contains claims 19-22, 30-32, 34-37 and 45 drawn to an invention nonelected with traverse in the reply filed on October 16, 2008. **A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144)** See MPEP § 821.01.

Duplicate Claims Warning

Applicant is advised that should claim 39 be found allowable, claim 44 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27, 28, 33 and 38 to 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art

that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no antecedent basis in the specification for M⁺ being "**at least one** selected from the group consisting of..." as recited in claim 33. The specification and the original claims recite "M⁺ is a cation, selected from the group consisting of...". Note page 2, lines 17 to 19 of the specification, for example.

There is no antecedent basis in the specification for R² being "an unbranched radical" or "a branched radical" as recited in claim 33. The specification and original claims recite "R² is selected from the group consisting of unbranched or branched **alkyl** radicals...". Note page 2, line 17, of the specification, for example.

There is no antecedent basis in the specification for A defined as "from 2.00 to 3.39" as recited in claims 27 and 42. The only place where these values for A appear is in the table on page 21. However, this table only supports the endpoints 2.00 and 3.39 for A. The range in between these points, for example 2.01 to 3.38, is not supported by the specification.

There is no antecedent basis in the specification for the foam value of from 720 to 730 according to EN 1890 92g/l) as recited in claims 28 and 43. The only place where these values

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for the foam value appear is in the table on page 21. However, this table only supports the endpoints 720 and 730 for the foam value. The range in between these points, for example 721-729, is not supported by the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 23 to 29, 33 and 38 to 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11, 23 to 29, 33 and 38 to 44 are drawn to **an alkyl ether sulfate of the formula I or II which is a single compound**. However, M^x in these claims includes "a mixture of 2-propyl heptyl and i-C₁₃ groups" or "at least one selected from the group consisting of ..." which would include more than one alkyl ether sulfate compound that is actually a composition containing alkyl ether sulfates.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33 and 38 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weil et al. (US 3843706), of record.

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses structurally similar compounds that are useful as biodegradable detergents. The compounds of the reference are structurally similar to the claimed alkyl ether sulfate compounds of the formula (II). Note the second and fourth compounds listed in Table IV in column 3.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds of the reference differ from the claimed compounds in that they are homologs. The group that corresponds to R in the claimed compounds is a C₁₂- or C₁₄-alkyl group instead of an i-C₁₃ group.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It has been held that homologs are obvious over one another. Note In re Wood, 199 USPQ 137, for example. One of

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ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful as biodegradable detergents would be obtained. The claimed compounds would have been rendered obvious by the homologs of the reference in the absence of any unobvious property.

Claims 11 and 23 to 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verdicchio (US 4726915), of record.

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses structurally similar compounds that are useful for detergent and cleansing compositions. The compounds of the reference are structurally similar to the claimed compounds of the general formula (I) wherein R is i-C₁₃ group; R¹ is methyl; M⁺ is an alkali metal or HNR₃²⁺; y is 1 or 2 and z is 4. Note column 2, lines 14 to 29 and in particular column 2, lines 49 to 56.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds of the reference differ from those claimed only in that the group that corresponds to R of the claimed compounds is C₁₀ alkyl instead of i-C₁₃ alkyl group.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It has been held that it is obvious to substitute one alkyl group for another. Note In re Hoke, 195 USPQ 148, for example.

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One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful for detergent and cleansing compositions would be obtained. The claimed alkyl ether sulfate salts would have been rendered obvious by the structurally similar compounds of the reference in the absence of any unobvious property.

Response to Arguments

The rejection of claim 11 under 35 U.S.C. 102(b) over Verdicchio (US 4726915) is withdrawn due to applicants' amendment of the claim.

Applicant's arguments, see Remarks, filed March 28, 2009, with respect to the rejection of claim 11 under 35 U.S.C. 103 over Weil (US 3843706) have been fully considered and are persuasive. The rejection of claim 11 under 35 U.S.C. 103 over Weil (US 3843706) has been withdrawn.

Applicant's arguments, see Remarks, filed March 28, 2009, with respect to the rejection of claim 11 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement have been fully considered and are persuasive. The rejection of claim 11 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement has been withdrawn.

Applicant's arguments filed March 28, 2009 with respect to the rejection of claim 11 under 35 U.S.C. 103 over Verdicchio (US 4726915) have been fully considered but they are not persuasive. Applicants state that Verdicchio fails to disclose or suggest any i-C₁₃ group-containing alkyl ether sulfate salt. However, the substitution of an i-C₁₃ group for the C₁₀ group of Verdicchio is within the knowledge generally available to one of ordinary skill in the art.

On pages 9 to 10 of the Remarks filed March 28, 2009, applicants discuss the results shown in the table on page 21 of the specification. The results shown in this table are not persuasive of the patentability of the claimed compounds because the prior art compounds closest in structure to the claimed compounds have not been compared. The compounds of Weil and Verdicchio discussed above are closer in structure to Examples 4, 5 and 6 of the table. For example, applicants have compared Example 4 which contains two propylene oxide(PO) groups and no ethylene oxide (EO) groups to Reference 4 which does not contain any PO or ethylene oxide (EO) groups. This example corresponds to the compounds of independent claim 33. The second and fourth compounds listed in Table IV in column 3 of Weil contain two PO groups just like Example 4 and are closer in structure to Example 4 of the table than Reference 4 which was compared.

The references made of record and not relied upon show the state of the art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T.

Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/
Primary Examiner, Art Unit
1626

ftp
May 29, 2009